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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,048	12/19/2000	Achim Storz	PD980044	6809

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Thomson Multimedia Licensing Inc CN 5312
Princeton, NJ 08543-0028

EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/720,048

Applicant(s)

STORZ ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 5/14/04. Claims 1-5 and 7-11 are pending. Claim 6 is cancelled. Claims 1-5 and 7-10 are amended. Claim 11 is new. The objections to the specification and abstract are withdrawn in light of the amendment. The objection to the bullet points in Claims 1 and 2 is withdrawn. Further, the 35 USC 112 rejection of Claims 1-10 is withdrawn in light of Applicant's argument. With respect to the claimed "programme places," the Examiner accepts Applicant's definition but advises Applicant that the terminology as used in the claim language is subject to the broadest possible interpretation.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,133,910 to Stinebruner.

Regarding Claim 1, Stinebruner discloses a method for using the programme places (See Figure 2) of a satellite receiver (See Figure 6, 116) by means of a television receiver (120) connected to the satellite receiver comprising supplying a selection signal from the television receiver to the satellite receiver for selecting a programme place of the satellite receiver and tuning the satellite receiver to the selected programme place (Col. 10, Lines 13-29). Further disclosed is that the satellite video source is coupled to the television (Col. 10, Lines 18-24). This TV is operable to receive the signal as a video source (See Figure 6, 116 and 126). This reads on the claimed transferring a TV signal received on the selected programme place from the satellite receiver to the television receiver. Stinebruner also discloses automatic programming of channel memory of all detected viewable channels (Col. 11, Lines 21-32) and that channel information may be encoded within the video stream of the satellite signal (Col. 11, Lines 57-61). This reads on the claimed determining the channel on the selected programme place of the satellite receiver from the channel identifying information by the television receiver. It is inherent, that in order to automatically program memory that there be means implemented to detect this channel identifying information which is embedded within the transferred TV, signal as stated above. The disclosed "automatic programming" to "detect viewable channels" in order to store a channel map in memory (Col. 5, Lines 56-56 and Figure 2) reads on the claimed storing an information assigning the determined channel to said selected programme place of the satellite receiver in the television receiver.

Regarding Claim 2, Stinebruner discloses a method as stated above in Claim 1, further comprising selecting a channel in response to a user input (Col. 5, Lines 57-63)

and outputting a control signal to the satellite tuner that corresponds to the source indicator for a given channel to tune the satellite tuner to the corresponding channel (Cols. 5-6, Lines 64-1). This reads on the claimed determining the satellite receiver program place of the selected channel from the stored channel information in the television receiver (See Figure 2), transferring a signal comprising the satellite receiver programme place from the television receiver to the satellite receiver and switching the satellite receiver to the satellite receiver programme place.

Regarding Claim 3, Stinebruner discloses a method as stated above in Claim 2, wherein the programme place of the satellite receiver is assigned to the programme place of the television receiver (See Figure 2). In this case, satellite channel 2 is assigned to television receiver channel 2, and satellite channel 12 is assigned to television receiver channel 7, for example. Further, corresponding information is stored in the television receiver as stated above.

Regarding Claim 4, Stinebruner discloses a method as stated above in Claim 3, wherein a user is operable to select a channel from the television receiver, resulting in a command being transmitted to the satellite receiver to tune to the given channel as stated above in Claim 2. This reads on the claimed for selection of a programme place of the television receiver the satellite receiver is switched to the corresponding programme place.

Regarding Claim 8, Stinebruner discloses a method as stated above in Claim 1, wherein a request to change channels is made of the satellite receiver by the television receiver in response to a user command as stated above. It is inherent that when a request

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to change channels is made, that the satellite receiver would consult its internal channel map in order to locate the proper frequency of the channel to be tuned to. This reads on the claimed program search being started in the satellite receiver upon reception of the signal supplied by the television receiver.

Regarding Claim 11, see Claim 1 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinebruner.

Regarding Claim 5, Stinebruner discloses a method as stated above in Claim 1.

What is not disclosed, however, is that VBI information is updated in the case of a channel change recognized by a changed channel identifying information. Official Notice is hereby taken that it is well known in the art to update VBI information when a channel is changed. This could be, for instance, displaying the closed captioning titles for the newly selected channel instead of the old channel. Further, a user is operable to cause a channel change by transmitting a channel identifying information command to the receiver as stated above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Stinebruner

with the updating of VBI information of the well-known prior art in order to present the user with the correct information from the channel they selected instead of incorrect information from a channel they were previously on. This reads on the claimed VBI information being updated in case of a channel change recognized by a changed channel identifying information.

Regarding Claim 7, Stinebruner discloses a method as stated above in Claim 1, wherein an automatic programming routine detects viewable channels based on embedded channel identification information as stated above. It is inherent that in order to automatically detect a plurality of channels, the receiver must be operable to examine each channel for embedded information. What is not disclosed, however, is that the steps are repeated for successive programme places of the satellite receiver. Official Notice is hereby taken that it is well known in the art to successively step through the tuning of a plurality of channels in order to auto program a receiver's memory. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Stinebruner with the repeated tuning for successive programme places of the well-known prior art in order to detect channel identifying information for each channel that is tunable by the satellite receiver in a single bulk operation requiring no user intervention or complicated programming knowledge.

Regarding Claim 9, Stinebruner discloses a method as stated above in Claim 8. What is not disclosed, however, is that the programme search is automatically started if no signal is received at the first programme place. Official Notice is hereby taken that it is well known in the art that a signal receiver may automatically search for a channel with

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signal if no signal can be found on the present channel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Stinebruner with the automatic programme search of the well-known prior art in order to prevent the system from tuning to channels that do not exist and consequently confusing the television receiver.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stinebruner in view of U.S. Patent No. 5,625,422 to Kim.

Regarding Claim 10, Stinebruner discloses a method as stated above in Claim 1. What is not disclosed, however, is that the television receiver is a video recorder. Kim discloses a video recorder (Col. 1, Lines 6-11) with a channel memory device and tuner (Col. 2, Lines 36-46) for storing channel data and controlling channel selection (Cols. 5-6, Lines 64-4). Kim is evidence that ordinary workers in the art would recognize the benefits of using a video recorder to store channel mapping data and allowing a user to tune to channels. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Stinebruner with the video recorder of Kim in order to allow a user to properly tune to and record programming from a satellite receiver.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

mrdr
July 14, 2004

Chris Grant
CHRIS GRANT
PRIMARY EXAMINER